

## **II. REMARKS**

In the March 18, 2004 Office Action, the Examiner originally rejected claims 1-305 under the judicially created doctrine of double-patenting over claims 1-186 of U.S. Patent No. 6,208,273. As noted by the Examiner, a timely filed Terminal Disclaimer may be used to overcome a double-patenting rejection. Without prejudice to later argue that it was not necessary, Applicants submitted a Terminal Disclaimer to overcome the double-patenting rejection.

In the Examiner's current Office Action, the Examiner now appears to ignore the original double-patenting rejection, and does not acknowledge Applicants filing of a Terminal Disclaimer. The Examiner now rejects several of the claims under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,936,560 to *Higuchi*. It is unclear if the Examiner is asserting new grounds for rejection, and if so, why such new grounds for rejection were necessitated, particularly in view of Applicants filing of a Terminal Disclaimer. Nonetheless, without prejudice to arguing that such new grounds for rejection are inappropriate, at least for the reasons discussed below, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. § 103(a).

Applicants appreciate the Examiner's allowance of several of the claims. The following remarks address the remaining claims that were rejected under 35 U.S.C. § 103(a) as being unpatentable over the *Higuchi* patent.

It is the Examiner's burden to factually support any *prima facie* conclusion of obviousness. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See M.P.E.P. § 2143.03. Furthermore, it is the Examiner's burden to factually support the alleged motivation to combine the cited prior art. The Examiner's duty may not be satisfied by engaging in impermissible hindsight;

any conclusion of obviousness must be reached on the basis of facts gleaned from the prior art. The preferred evidence to be offered by the Examiner is an express teaching to modify/combine which is set forth within objectively verifiable sources of prior art. *See* M.P.E.P. §§ 2141-2144.

In a recent decision from the United States Court of Appeals for the Federal Circuit, the Federal Circuit noted that when the patent examiner and Board "rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record." *In re Sang-Su Lee*, 277 F.3d 1338, 1345 (Fed. Cir. 2002). Specifically, the Federal Circuit noted that conclusory statements about what is "basic knowledge" or "common sense" by themselves do not adequately support a determination of unpatentability. *See Id.* at 1343-44. Thus, the Federal Circuit held that findings of obviousness based on "common knowledge" must be supported by documented evidence that such knowledge exists. *See Id.* at 1344-45.

Here, the Examiner admits that *Higuchi* does not teach all the claim elements, and has only offered conclusory statements that the claim elements not taught by *Higuchi* would have been "obvious" or "well-known." The Examiner has not supported such statements with documented evidence, as the Examiner is required to do, and Applicants hereby bring the lack of support to the Examiner's attention. Accordingly, the claims were improperly rejected under § 103 and should be allowable over *Higuchi*.

Applicants further note that U.S. Patent No. 6,208,273, referenced above, and assigned to the same assignee as the present application, was allowed and issued over the *Higuchi* patent. As indicated above, in the March 18, 2004 Office Action, the Examiner took the position that all the claims of the present application were unpatentable over U.S. Patent No. 6,208,273 under the doctrine of obviousness type double-patenting because the claim elements of the patent and the present application are substantially the same. (As a result, Applicants submitted a terminal disclaimer.) Thus, since U.S. Patent No. 6,208,273 was allowed and issued over the *Higuchi* patent,

and the Examiner considers the claims of the patent and the present application to be substantially the same, it is nonsensical and inappropriate for the Examiner to reject the present claims over *Higuchi* while substantially the same claims were allowed and issued over *Higuchi* in U.S. Patent No. 6,208,273.

### **III. CONCLUSION**

In view of the remarks set forth herein, this application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



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### **CERTIFICATION UNDER 37 C.F.R. § 1.8**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Amendment, COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450, on June 23, 2005.



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